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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,216	01/29/2001	Michel Schneider	1201-86	8806

7590

08/14/2003

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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,216

Applicant(s)

SCHNEIDER ET AL.

Examiner

Shahnam Sharareh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 35-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-34 and 48-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Amendment filed on May 20, 2003 has been entered. Claims 1-21, 38-47 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8. Claims 22-34, 48-60 are under consideration.

Effective Priority Date

Applicant arguments with respect to the effective priority date have been fully considered but are not found persuasive. Applicant argues that only claims 26, 52 should be subject to the filing date of January 29, 2001 and all other claims should be entitled to an effective filing date of November 2, 1992.

In response, Examiner does not ^{agree} with Applicant's conclusion. Examiner agrees with Applicant's statement that determination of an effective priority date must be made on a claim by claim basis. Accordingly, consistent with such approach, Examiner determined the effective priority date of this application to be January 29, 2001. Examiner points out that determining the effective priority date of each claim requires assessment of the entire scope of said claim. In the instant case, claims 26 and 52 respectively depend on claims 22 and 48. Therefore, the entire scope of claims 22 and 48 include such straight chain fatty acid such as arachidic, behenic or lignoceric acids.

Claims 26 or 52 are not independent claims and, thus, not excluded for establishing the proper priority date of their base claim. Subsequently, since the parent cases do not convey with reasonable clarity to those skilled in the art that, as of the

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filing date sought, that the inventor was in possession of the invention in the parent cases, the effective priority date of the instant application remains January 29, 2001.

Claim Rejections - 35 USC § 103

Claims 22-34, 48-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beller et al US Patent 5,599,523 in view of Unger et al US Patent 5,542,935, Klaveness US Patent 5,529,766 and Quay US Patent 5,393,424.

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive. Applicant argues lack of motivation or suggestion in the combined references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, all elements of the instant claims are taught in combined teachings of the prior art, therefore, claims stand rejected for the reasons of record.

In response to applicant's argument that the proposed modification can not change the principle of operation of a reference, Examiner states no evidence has been provided to substantiate such arguments. All cited references are in the same field of endeavour and thus analogous in nature. Further, the only missing element in Beller is the explicit teaching of freezes dried formulations containing SF6. Therefore, Examiner does not agree with Applicant's contention that the nature of operation is modified

merely because Beller's composition may be freeze-dried, because such process is conventionally used and taught by the cited references.

Double Patenting

Claims 22-34, 48-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 5,380,519 and claims 1-50 of US Patent 6,110,443 for the reasons of record. However, this issue is held in abeyance per applicant's request.

Conclusion

No claims are allowed. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

SS
August 11, 2003


RUSSELL TRAVERS
PRIMARY EXAMINER